

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) GB920020091US1
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____ filed on May 24, 2007</p> <p>Signature _____ /Louise Fay/</p> <p>Typed or printed name _____ Louise Fay</p>		<p>Application Number 10/698,174</p> <p>Filed 10-30-2003</p> <p>First Named Inventor Lambert et al.</p> <p>Art Unit 2132</p> <p>Examiner Koempel-Thomas, Beatrice L.</p>

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 48,504
Registration number _____

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Theodore D. Fay III/

Signature

Theodore D. Fay III

Typed or printed name

972-385-8777

Telephone number

May 24, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: **Lambert et al.** §
§
Serial No.: **10/698,174** § Group Art Unit: **2132**
§
Filed: **October 30, 2003** § Examiner: **Koempel -Thomas, Beatrice L.**
§
For: **System for Controlling Access to** § Attorney Docket No.: **GB920020091US1**
Stored Data §
§

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to Deposit Account No. 09-0447.

REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed February 27, 2007. The Request is provided herewith in accordance with the rules of the OG of July 12, 2005. The pre-appeal brief review is required because the rejections are clearly in error.

I. Objection to the Specification and the Drawings

The examiner objects to the specification on the basis that, "environment (230)," (page 8 line 19, reference number added in the amendment), appears to refer to the same environment as "an environment (100)," (page 8 line 11). Different reference numbers should not be used for the same element." However, this objection is clearly in error because environment 230 is not the same as environment 100. Environment 100 refers to multiple users 105 using shared device 110. See specification, page 6 and Figure 1. Environment 230 refers to an environment, "wherein a user (105) has access to a device (110), the device comprising stored data." See amendment filed January 10, 2007 and specification page 6. The environments are plainly distinct; thus, the objection is clearly in error. Accordingly, the objection to the specification should be withdrawn. The objection to the drawings is based on the same clearly erroneous objection to the specification. Therefore, the objection to the drawings is clearly in error. Accordingly, the objection to the drawing should be withdrawn.

II. Rejection of Claims 12, 17, and 18 under 35 U.S.C. § 101

The examiner rejects claims 12, 17, and 18 as non-statutory. This rejection is clearly in error. Claim 12 has been amended to clearly recite that the computer program is on a tangible medium. The examiner asserts that the term "a computer program on a tangible medium," "may be taken to mean a program listing recorded on a computer readable storage medium without any functional interrelationship." However, the examiner's assertion is clearly erroneous because the functional interrelationship is provided by the claimed steps in the body of claim 12. Additionally, by claiming that the computer program is on a tangible medium, Applicants have specified that the claimed invention is embodied in a physical form, thus complying with the Guidelines.

Additionally, over 303 patents, as of the date of this pre-appeal brief request, include the exact same language provided in claim 12. See, for example, the following claim (emphasis supplied) from Grill, Method For Operating A Motor Vehicle, U.S. Patent 7,212,905 (May 1, 2007):

10. *A computer program on a tangible medium comprising a program suitable for carrying out a method for operating a motor vehicle when executed on a computer and stored on a storage medium, the method including the steps of: determining a target region (TR) forward of said motor vehicle; providing an operating recommendation to the driver in dependence upon the determination of said target region (TR); determining an arrival probability (PCOL) at said target region (TR) when the time (TTC), which would be necessary for reaching said target region (TR) at undiminished speed, is at most equal to a third limit value (T2) and/or when the distance (DS) of said motor vehicle to said target region (TR) is at most equal to a fourth limit value (S2); and, outputting said operating recommendation to said driver when said arrival probability (PCOL) at least reaches a first limit value (PLIM).*

Presumably, Grill and most, if not all of these patents, were examined under the new Guidelines. Given that these applications issued with the same claim language as that presented in claim 12, Applicants are also entitled to allowance of claim 12 using the above-presented claim language. Therefore, the rejection under 35 U.S.C. § 101 is clearly in error and should be withdrawn.

Furthermore, the examiner's assertion that claim 12 does not produce a useful, tangible, or concrete result is also clearly erroneous. Claim 12 provides for accessing a set of *stored* data. By accessing *stored* data, the physical nature of the tangible medium is altered, thereby creating a tangible result. The rejection of claims 17 and 18 is clearly in error for similar reasons. Thus, again, the rejection under 35 U.S.C. § 101 is clearly in error and should be withdrawn.

III. Obviousness Rejections

The examiner rejects as obvious all of the claims under various combinations of *Holvey et al., Method and System for Protecting Information on a Computer System*, U.S. Patent Application Publication 2004/0054935 (March 18, 2004). Specifically, the

examiner rejects claims 1-8 and 10-12 as obvious in view of *Holvey* and *Mashayekhi*, System and Method for Automatically Authenticating a User in a Distributed Network System, U.S. Patent 5,818,936 (October 6, 1998). The examiner rejects as obvious claim 9 in view of *Holvey*, *Mashayekhi*, and *Chadwick*, Smart Cards Aren't Always the Smart Choice, IEEE Computer, December 1999, v. 32, issue 12, pp. 142-143. The examiner rejects as obvious claims 13-18 in view of *Holvey*, *Mashayekhi*, and *Mita* et al., Medical Data Sharing Method and Medical Data Sharing System Using the Method, U.S. Patent Application Publication 2002/0035485 (March 21, 2002).

Applicants first address the rejection of claim 1 in view of *Holvey* and *Mashayekhi*. The examiner fails to state a *prima facie* obviousness rejection because the combination of *Holvey* and *Mashayekhi*, considered as a whole, fails to teach or suggest the claimed feature of “means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set,” as required in claim 1. The examiner’s assertions to the contrary are clearly incorrect, just as the assertions to the contrary were clearly incorrect in the first office action with regard to *Lambert*.

The examiner relies on table 1 and paragraphs 23 and 24 of *Holvey* as teaching the feature of a user specific table. The examiner specifically states that, “patient medical records and associated authorized users” are the user specific table. However, a plain reading of paragraphs 23 and 24 shows that no basis exists to assert that the patient medical records are a “user specific table.” The information may relate to specific users, but *Holvey* is completely silent on how the information is stored. *Holvey* simply does not state that the information is in the form of a user specific table and *Holvey* gives no hint or suggestion that the information should be stored in a user specific table.

Holvey does provide a “table” in the form of table 1. However, table 1 describes “the access rights of each type of user to the patient's medical records.” Thus, table 1 refers to an exemplary set of access rights belonging to *types* of users. *Holvey* does not refer to *user specific* tables, but rather to *types* of users. Additionally, and even more importantly, *Holvey* does not state and does not give any hint or suggestion that table 1 is actually stored in the form of a user specific table. *Holvey* does not describe how the information is stored at all. In light of the fact that, in the art, such information is usually

stored in massive relational databases or object oriented databases, no reasons exists to assume that the rights shown in table 1 are stored in a *user specific* table.

Thus, *Holvey* does not teach or suggest the claimed feature of, “means, responsive to successful authentication, for decrypting a user specific table associated with the user, wherein the user specific table identifies the set.” *Mashayekhi* also does not teach or suggest this claimed feature. In fact, *Mashayekhi*, which is directed towards user identification in a network, is devoid of disclosure regarding user specific tables.

Because neither *Holvey* nor *Mashayekhi* teach or suggest this claimed feature, the proposed combination considered as a whole also fails to teach or suggest this claimed feature. Therefore, the examiner failed to state a *prima facie* obviousness rejection.

Additionally, *Holvey* and *Mashayekhi* are directed towards wholly different subject matter. For this reason, no reason exists to combine the references to achieve the invention of claim 1. Accordingly, again, the examiner failed to state a *prima facie* obviousness rejection of claim 1.

The remaining rejections all rely on the clearly erroneous assertion that *Holvey* discloses the use of a user specific table, as claimed. Therefore, the obviousness rejections are all clearly in error. Accordingly, the rejections should be withdrawn.

IV. Conclusion

The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 05/24/07

Respectfully submitted,

/Theodore D. Fay III/

Theodore D. Fay III
Reg. No. 48,504
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants